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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,383	08/20/2004	Peter J Dronzek JR.	181-039	7142
7590 09/11/2008				
James V Costigan Hedman & Costigan 1185 Avenue of the Americas New York, NY 10036-2601			EXAMINER NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			09/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,383

Applicant(s)

DRONZEK ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15, 17-26, 28-37, 39-48, 50-59, 61-70, 72-81 and 83-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15, 17-26, 28-37, 39-48, 50-59, 61-70, 72-81 and 83-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 23, 2008 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 4, 6 – 15, 17 – 26, 28 – 37, 39 – 48, 50 – 59, 61 – 70, 72 – 81 and 83 – 107 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 – 6 and 8 – 53 of copending Application No. 10/505,392.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to an article comprising a first, second and third thin film layers laminated together and having a card define therein by die-cut variable surface treatment for variable adhesion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-15, 17-26, 28-37, 39-48, 50-59, 61-70, 72- 81, 83-88 and 97 – 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan (USPN 4,544,590) in view of Caputo et al. (USPN 4,840,270).

Egan (for claims 1, 12, 24, 34, 45, 56, 67, 78, 97) relates to an article of manufacture (figure-6) comprising a first support layer of film (1+2) with a permanent bond interface with adhesive (19), a second thin film (13) is adhesively secured to the lower surface of the first film at the permanent adhesive bond but having a separable interface between the adhesive and the release coat of film (13), and a third substrate (33) is laminated to the upper surface of the first layer with adhesive (37). As shown in figure-9, the article is a die-cut segment (47) wherein in

the die-cut extends through all the layers except for film (13). The removable die-cut segment is provided with a selective variable adhesion through variable surface treatment (figure-21, wherein the release coat is provided in a discontinuous pattern) of the upper surface of film (13) such that the adhesion at the separable interface (between the release liner and the adhesive) is always less than the adhesion at the permanent interface between the adhesive and the film (1+2). This discontinuous pattern is formed by applying no surface treatment in some areas and surface treatment in other areas (as shown in figure-19-21 of Egan, the surface includes treated and non-treated areas for forming a variable adhesion, col. 9, lines 35-42 and 51-61, and col. 10, lines 1-5). For claims 2, 13, 24, 35, 46, 57, 68, 79, the treated area extends under the removable area defined by the die-cut as shown in figure-21. For claims 3, 14, 25, 36, 47, 58, 69, 80, the film layer is polyester and is about 0.5 mils thick (col. 6, lines 1-10). As for claims 4, 15, 26, 37, 48, 59, 70, 81, the substrate layer can be of paper stock of 40-, 50-, or 60-pound weight (col. 6, lines 50-55). For claims 7-10, 18-21, 29-32, 40-43, 51-54, 62-65, 73-76, 84-87, figure-21 shows that the area treated can be at least 10% but less than 90% and is of a geometric pattern such as a polygon. The intended use phrases such as “for providing”, etc. and “optional” phrases have not been given any patentable weight because said phrases are found to be of positive limitations. Claims 11, 22, 33, 44, 55, 66, 77, 88, are directed to a surface treatment condition in the process of making the product and has not been given any patentable weight because said process condition is not germane to the issue of patentability of the product itself. However, Egan fails to disclose applying no surface treatment in some areas and surface treatment in other areas by flame treatment, corona treatment or plasma treatment.

Caputo et al. teach applying no surface treatment in some areas and surface treatment in other areas by corona treatment (Figure 3, #20; Column 2, lines 48 – 52) for the purpose of providing enhanced adhesion (Column 2, lines 52 – 54).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided selective treatment on a surface in Egan in order to enhance adhesion as taught by Caputo et al.

6. Claims 89 – 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egan (USPN 4,544,590) in view of Caputo et al. (USPN 4,840,270) as applied to claims 1-4, 6-15, 17-26, 28-37, 39-48, 50-59, 61-70, 72- 81, 83-88 and 97 – 102 above, and further in view of Grabau et al. (USPN 7,045,186).

Egan, as modified with Caputo et al., fails to teach a radio frequency transmitter in at least one of the article elements.

Grabau et al. teach a label with a radio frequency transmitter in at least one of the elements of the label (abstract). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Grabau's teaching of using radio frequency transmitter in a label in the invention of Egan with the motivation to provide for security and concern.

Response to Arguments

7. Applicant's arguments with respect to claims 1 – 4, 6 – 15, 17 – 26, 28 – 37, 39 – 48, 50 – 59, 61 – 70, 72 – 81 and 83 – 102 have been considered but are moot in view of the new ground(s) of rejection.

With regard to the prior art not teaching selective corona, plasma or flame treatment, please see the newly presented rejection above.

With regard to Applicant's argument about the rejection of claims 11, 22, 33, 44, 55, 66, 77 and 88 not being proper with regard to the process limitation not being germane to the patentability of the product as the structure may be defined by the process which it is made, the claim limitations provide no structural limitations as the language states there only a surface tension is present.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794